



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,763	04/09/2004	Robert Winskowicz	PI-101	1461
23639	7590	12/12/2008	EXAMINER	
BINGHAM MCCUTCHEN LLP			TRIMIEW, RAEANN	
Three Embarcadero Center				
San Francisco, CA 94111-4067			ART UNIT	PAPER NUMBER
			3711	
			MAIL DATE	DELIVERY MODE
			12/12/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/821,763

Filing Date: April 09, 2004

Appellant(s): WINSKOWICZ ET AL.

Erin M. Dunston
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 8/18/08 appealing from the Office action mailed 7/2/07.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

Claims 1-8, 10, 11, 14, 16-17, 25, and 29 are rejected

Claims 12, 13, 15, 18-24, 26-28, and 30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 9 is withdrawn from consideration as not directed to the elected invention.

Claim 31 is allowed.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

NEW GROUND(S) OF REJECTION

Claims 1-8, 10-11, 14, 16, 17, 25, and 29 are rejected under 35 U.S.C. 102(b) as anticipated by Winskowicz (6,358,160).

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,358,160 WINSKOWICZ 3-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-8, 10-11, 14, 16, 17, 25, and 29 are rejected under 35 U.S.C. 102(b) as anticipated by Winskowicz (6,358,160). Claim 1, Winskowicz discloses a golf ball comprising a glossy coating (masking layer) over the surface. Once the coating is penetrated an indicator or mottled area will appear on the surface (figs 2). The mottled surface indicates the ball has been exposed to water and has changed characteristics. With respect to claims 2-5, the coating layer inherently includes all the limitations when exposed to water. The coating layer also includes a water activated binder since it is

capable of being penetrated by water. Claim 6, the mottled area inherently has a predetermined color since it is made from ink, see figures. Claims 7-8, the indicator may be indicia and is printed on the surface of the ball (fig 9-10). Claims 10-11, the glossy coating (mask) is inherently dissolved in the presence of water. Claim 14, the glossy coating is made from a polymer which is activated by water. Claims 16-17, the glossy coating is made from a polymer which inherently includes bubbles or voids when activated by water. Claim 25, the glossy coating is made from a polymer which is activated by water. Claim 29, the polymer is swellable (col. 3, lines 55-56).

(10) Response to Argument

Appellant argues claim 1 is a method for providing a golf ball comprising a water activated mask and a covered indicator. Once the masking layer is removed or dissolved the indicator appears and is in its final indicator state. However, Appellant's arguments do not coincide with the claimed invention. Claim 1, clearly states, '...applying a water-activated mask that is altered to permit viewing of a covered indicator upon being subjected to water.'. Contrary to appellant's arguments the claims do not limit or even acknowledge the 'state' of the indicator. The claim simply requires the presence of 'a covered indicator'. The prior art, Winskowicz, clearly discloses a golf ball comprising a water activated mask or glossy coating that covers the indicator (mottled area or indicia). Appellant further argues, 'The important point is that the indicator does not change. Instead, only the mask, upon being activated by water, changes.'.

Appellant's analysis is correct but it is not limited to an indicator that does not change.

Claim 1 as currently written only requires the presence of a covered indicator. The state of the indicator at the point it is revealed is not claimed.

Appellant argues the prior art, Winskowicz, is silent with respect to the refraction index as in claim 2 of the instant invention. Winskowicz discloses the glossy coating or masking layer dissolves in the presence of water. Once a material dissolves, any and all properties will inherently be changed, including the refraction index.

In regards to claim 3, Appellant argues the prior art, Winskowicz, mentions the concept of controlled degradation but requires the use of water activated inks with resins to establish controlled degradation. Appellant supports the rejection by clearly indicating Winskowicz discloses degradation of the glossy layer or mask. As disclosed by Winskowicz and supported by appellant, the glossy coating dissolves (degrade) upon contact with water, therefor the limitation is satisfied.

In regards to claim 4, Appellant argues the prior does not disclose the term 'sloughing off'. However, Winskowicz discloses the glossy coating 'dissolves', which is interchangeable with the term 'sloughing off'.

In regards to claim 5, Appellant argues the prior art fails to include microbial degradation. Again, Winskowicz discloses the glossy layer dissolves upon contact with water. Figure 1, of Winskowicz illustrates the golf ball in contact with water in a pond or lake. Outdoor ponds and lakes inherently contain microorganisms that will aid the water in dissolving the glossy coating.

In regards to claims 6-8, 10, and 11, appellant does not argue the limitations of the claims individually. However, as shown in the rejection above, Winskowicz

discloses an indicator with a predetermined color (fig 2). Claim 7, the indicator may be indicia (figs 9-10). Claim 8, the indicia is printed (fig 9). Claims 10 and 11, the glossy coating or mask is dissolved in the presence of water.

In regards to claim 14, appellant argues Winskowicz does not disclose a water-activated binder in the glossy layer or mask. Winskowicz discloses the glossy layer is a polymer that dissolves in the presence of water. The polymer inherently includes a binding material that binds the components of the polymer. Since the glossy coating dissolves, all the elements in the polymer (including the binder) will dissolve as well.

In regards to claims 16 and 17, appellant argues Winskowicz does not disclose bubbles or voids in the binder. However, Winskowicz discloses the glossy material is made from a polymer, which inherently includes a binder for binding the components of the polymer together. During manufacturing of materials such as polymers microscopic voids/bubbles are inherently present after mixing, kneading, etc. Also, voids/bubbles are present in the glossy coating during the degradation stage once activated by water.

In regards to claim 25 and 29, appellant does not argue the claims individually. However, the Winskowicz discloses the glossy coating is a polymer which inherently includes a binder for binding the polymer components and the polymer dissolves in the presence of water (claim 25). Claim 29, Winskowicz the polymer is swellable (col. 3, lines 55-56).

In conclusion it is submitted that appellant has failed to overcome the prior art of record, Winskowicz, for the following reason: Independent claim 1 limits the method to a golf ball comprising a water activated mask that is altered when in contact with water

and a covered indicator. Winskowicz discloses a golf ball comprising a water activated glossy coating or mask that covers an indicator. Contrary to appellant's arguments the 'state' of the indicator once the covering layer is dissolved is not limited by any of the claims as currently written.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained. This examiner's answer contains a new ground of rejection set forth in section **(9)** above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) Reopen prosecution. Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) Maintain appeal. Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of

Art Unit: 3711

rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

/Raeann Trimiew/

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

/Robert P Olszewski/

Director, Technology Center 3700

Conferees:

/Gene Kim/

Application/Control Number: 10/821,763
Art Unit: 3711

Page 9

Supervisory Patent Examiner, Art Unit 3711

/XUAN M. THAI/

Supervisory Patent Examiner, Art Unit 3715